Docket No.: RSW920010183US1 (7161-017U) **PATENT**

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

In re Application of	:	Customer Number: 46320
Virinder BATRA, et al.	:	Confirmation Number: 3519
Application No.: 10/077,012	:	Group Art Unit: 2145
Filed: February 15, 2002	:	Examiner: A. Choudhury

For: COMMON LOCATION-BASED SERVICE ADAPTER INTERFACE FOR LOCATION BASED SERVICES

APPEAL BRIEF

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Commissioner for Patents
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Sir:

This Appeal Brief is submitted in support of the Notice of Appeal filed November 17, 2006, and in response to the Examiner reopening prosecution in the Office Action dated May 30, 2007, wherein Appellants appeal from the Examiner's rejection of claims 1-6.

I. REAL PARTY IN INTEREST

This application is assigned to IBM Corporation by assignment recorded on February 15, 2002, at Reel 012618, Frame 0349.

II. RELATED APPEALS AND INTERFERENCES

Appellants are unaware of any related appeals and interferences.

III. STATUS OF CLAIMS

Claims 1-6 are pending and five-times rejected in this Application. It is from the multiple rejections of claims 1-6 that this Appeal is taken.

IV. STATUS OF AMENDMENTS

The claims have not been amended subsequent to the imposition of the Fifth Office Action dated May 30, 2007 (hereinafter the Fifth Office Action).

V. SUMMARY OF CLAIMED SUBJECT MATTER

Referring to Figure 1 and to independent claims 1 and 5, a method of processing requests 125 from location-based service applications 110 for location-based services provided by a plurality of disparate location-based service providers 150 by a location service 140 is disclosed. Different ones of the plurality of disparate location-based service providers 150 specify different formats for receiving the requests 125/135 (page 8, line 21 through page 9, line 6 of Appellants' disclosure). The requests 125 are received for location based-services 140 (page 8, lines 16-22). From each request 125, a particular location-based service provider 150, which can service the request 125, is determined (page 8, line 21 through page 9, line 3). Each request 125/135 is specifically formatted according to a specific format specified by the particular location-based service provider 150 (page 9, lines 12-13). Each result set 115 produced from corresponding ones of the requests 135 is uniformly formatted (page 9, lines 13-18). The uniformly formatted result sets 145 are forwarded to the location-based service applications 110 (page 10, lines 1-8).

Referring to Figure 1 and to independent claim 3, a common location-based service adapter interface 140 that includes a uniform input interface and uniform output interface is

disclosed (page 8, lines 13-20). Location-based services are requested 125 through the uniform input interface using a uniform format which is independent of any specific formatting required by a particular service adapter 150 configured to process the location-based services (page 8, line 21 through page 9, line 11). Specifically formatted result sets can be formatted using the uniform format through the uniform output interface (page 10, lines 1-9). The uniform input interface is adapted to be connected to different service adapters 150 specifying different formats for receiving inputs (page 8, line 21 through page 9, line 6).

VI. GROUND OF REJECTION TO BE REVIEWED ON APPEAL

1. Claims 1-6 were rejected under 35 U.S.C. § 102 for anticipation based upon McDowell et al., U.S. Patent Publication No. 2002/0035605 (hereinafter McDowell).

VII. ARGUMENT

THE REJECTION OF CLAIMS 1-6 UNDER 35 U.S.C. § 102 FOR ANTICIPATION BASED UPON MCDOWELL

For convenience of the Honorable Board in addressing the rejections, claims 2 and 5-6 stand or fall together with independent claim 1, and claim 4 stands or fall together with independent claim 3.

The factual determination of anticipation under 35 U.S.C. § 102 requires the identical disclosure, either explicitly or inherently, of each element of a claimed invention in a single reference.[1] Moreover, the anticipating prior art reference must describe the recited invention

[1] In re Rijckaert, 9 F.3d 1531, 28 USPQ2d 1955 (Fed. Cir. 1993); Richardson v. Suzuki Motor Co., 868 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989); Perkin-Elmer Corp. v. Computervision Corp., 732 F.2d 888, 894, 221

with sufficient clarity and detail to establish that the claimed limitations existed in the prior art and that such existence would be recognized by one having ordinary skill in the art.[2] As part of this analysis, the Examiner must (a) identify the elements of the claims, (b) determine the meaning of the elements in light of the specification and prosecution history, and (c) identify corresponding elements disclosed in the allegedly anticipating reference.[3] This burden has not been met.

As noted by the Supreme Court in Festo Corp. v. Shoketsu Kinzoku Kogyo Kabushiki Co.,[4] a clear and complete prosecution file record is important in that "[p]rosecution history estoppel requires that the claims of a patent be interpreted in light of the proceedings in the PTO during the application process." The Courts that are in a position to review the rejections set forth by the Examiner (i.e., the Board of Patent Appeals and Interferences, the Federal Circuit, and the Supreme Court) can only review what has been written in the record; and therefore, the Examiner must clearly set forth the rationale for the rejection and clearly and particularly point out those elements within the applied prior art being relied upon by the Examiner in the statement of the rejection.

This requirement that the Examiner clearly set forth the rationale for the rejection and clearly and particularly point out those elements within the applied prior art being relied upon by the Examiner in the statement of the rejection is found in with 37 C.F.R. § 1.104(c), which reads:

USPQ 669, 673 (Fed. Cir. 1984).

[2] See In re Spada, 911 F.2d 705, 708, 15 USPQ 1655, 1657 (Fed. Cir. 1990); Diversitech Corp. v. Century Steps, Inc., 850 F.2d 675, 678, 7 USPQ2d 1315, 1317 (Fed. Cir. 1988).

[3] Lindermann Maschinenfabrik GMBH v. American Hoist & Derrick Co., 730 F.2d 1452, 221 USPQ 481 (Fed. Cir. 1984).

[4] 535 U.S. 722, 122 S.Ct. 1831, 1838, 62 USPQ2d 1705, 1710 (2002).

> In rejecting claims for want of novelty or for obviousness, the examiner must cite the best references at his or her command. When a reference is complex or shows or describes inventions other than that claimed by the applicant, the particular part relied on must be designated as nearly as practicable. The pertinence of each reference, if not apparent, must be clearly explained and each rejected claim specified.

Moreover, in the unpublished opinion of Ex parte Pryor[5], the Board of Patent Appeals and Interferences recognized the necessity for an Examiner to supply sufficient information to establish a prima facie case of anticipation. Specifically, the Board wrote:

> At the outset, we note the examiner has been of little help in particularly explaining the rejections on appeal. A mere statement that claims stand rejected "as being clearly anticipated by" a particular reference, without any further rationale, such as pointing out corresponding elements between the instant claims and the applied reference, fails to clearly make out a prima facie case of anticipation. (emphasis in original)

Despite the very specific requirement for the Examiner to clearly set forth the rationale for the rejection and clearly and particularly point out those elements within the applied prior art being relied upon by the Examiner, the Examiner has failed to do so. Instead, the Examiner's statement of the rejection simply consists of the Examiner repeating, almost word-for-word, each of the recited claims and asserting that an entire passage within the claim is disclosed by certain specified paragraphs within McDowell. The manner in which the Examiner conveyed the statement of the rejection, however, has not "designated as nearly as practicable" the particular parts in McDowell being relied upon in the rejection.

It is practicable for the Examiner, for each of the claimed elements, to specifically identify each feature within McDowell being relied upon to teach each of the particular claimed elements. For example, the Examiner can "specifically identify" a feature, corresponding to the claimed element, within the applied prior art by identifying a reference numeral associated with the feature. In addition to or alternatively, the Examiner may cite to a brief passage (i.e., 1 or 2

[5] Appeal No. 1997-2981.

lines or even a portion of a line) within the applied prior art that identifies the feature that corresponds to the claimed element. However, merely citing an entire paragraph(s) to disclose a single (or multiple) claimed elements does not designate "as nearly as practicable," the particular features within McDowell being relied upon by the Examiner in the rejection.

The importance of the specificity requirement of 37 C.F.R. § 1.104(c) is also further evident in M.P.E.P. § 706.07, which states:

> The examiner should never lose sight of the fact that in every case the applicant is entitled to a full and fair hearing, and that a clear issue between applicant and examiner should be developed, if possible, before appeal.

A clear issue, however, cannot be developed between Appellants and the Examiner where the basis for the Examiner's rejection of the claims is ambiguous. The Examiner's "analysis" provides little insight as to (i) how the Examiner is interpreting the elements of the claims and (ii) what specific features within McDowell the Examiner believes identically discloses the specific elements (and interactions between elements) recited in the claims. By failing to specifically identify those features within McDowell being relied upon in the rejection, the Examiner has essentially forced Appellants to engage in mind reading and/or guessing to determine how the Examiner is interpreting the elements of the claims and what specific features within McDowell the Examiner believes identically disclose the claimed invention.

Claim 1

Referring to pages 2 and 3 of the Fifth Office Action, in asserting that McDowell identically discloses the limitations recited in independent claim 1, the Examiner essentially cited paragraphs [0077]-[0081] and [0083] of McDowell with no additional analysis.

Referring to independent claim 1, (i) requests are received for location-based services from location-based service applications (see preamble and first limitation), (ii) a particular provider for the location-based service is identified from the request, (iii) the request is formatted based on the particular provider, (iv) results sets from providers are uniformly formatted, and (v) the uniformly formatted result sets are forwarded to the location-based service applications which originated the request.

The teachings of McDowell, however, are completely different. Referring to paragraph [0077], a location proxy server (LPS): (1)/(2) retrieves location information from Position Determining Equipment (PDE) and from other networks; (3) formats and processes the location information, and (4) delivers the location information. The Examiner cited this passage to teach the claimed request are received for location-based services. However, paragraph [0077] is completely silent as to request for location-based services. Instead, paragraph [0077] discusses the retrieval and processing of location information.

The Examiner also cited paragraph [0077] to teach the claimed "specifically formatting each said request according to a specific format specified by said particular location-based service provider." Not only does paragraph [0077] not teach formatting based upon "a specific format specified by said particular location-based service provider," this paragraph also does not teach "specifically formatting each request." What is being formatted by McDowell is not a request. Instead, McDowell teaches formatting location information.

Paragraphs [0078] and [0079] of McDowell further detail how the location information is retrieved from the PDE and from other sources, such as networks. Paragraph [0080] further describes how the LPS formats and processes the location information to produce a "final format location 'atom'". Paragraph [0081] describes how the location information is delivered "to platforms outside the wireless network" and "to services inside the wireless network." Paragraph [0083] is reproduced, in part, below:

> Referring to FIG. 2, subscriber-initiated location-sensitive Web browsing is illustrated. The process is initiated when a wireless subscriber 210 uses a WAP browser to request 201 location-sensitive information (e.g., driving directions) from a Web service (URL) 220. The WAP Gateway 136 automatically recognizes that location information is needed and queries 202 the PLIM system's LPS 114 for the most recent location information on the subscriber. The LPS verifies 203 that the privacy database 119 reflects that the subscriber has given permission for her location information to be provided to the Web service 220. If current location information is not available, the LPS 114 queries 204 the PDE 130 to obtain it. Alternatively, the PDE 130 may already be configured to "stream" location updates into the LPS 114. The LPS 114 provides 205 the subscriber's location information to the WAP Gateway 136. The WAP Gateway 136 embeds the location information into the requested URL and forwards it 206 to the Web service 220. A location-sensitive response from the Web service 220 is returned 207 to the subscriber 210 via the WAP Gateway 136. (emphasis added)

Referring to Fig. 2 of McDowell, the wireless subscriber 210 sends a request 201, which is received by the WAP Gateway 136. However, the feature the Examiner relied upon in paragraph [0077]-[0081] is the Location Proxy Server (114). Thus, the request 201 for location-based services is not received by the LPS 114.

As to the claimed step of "determining from each said request a particular location-based service provider which can service said request," the Examiner relied solely upon paragraph [0083] to teach this limitation. Completely absent from this passage, however, is a determination, from each request, of a particular location-based service provider which can service the request. As stated in the preamble of claim 1, the location-based services are provided by a plurality of disparate location-based service providers, and thus, a selection of a particular one of these location-based service providers is performed. Appellants, however, are

unable to determine where a plurality of disparate location-based service providers are disclosed by McDowell and where a selection of a particular one is made.

Therefore, for the reasons stated above, Appellants respectfully submit that the Examiner has failed to establish a prima facie case of anticipation in rejecting claim 1 under 35 U.S.C. § 102 based upon McDowell.

Claim 3

Independent claim 3 recites, in part, the following limitation:

> a uniform input interface through which location-based services can be requested using a uniform format which is independent of any specific formatting required by a particular service adapter configured to process said location-based services.

On page 3 of the Office Action, to teach these limitations, the Examiner cited paragraph [0083] and stated "McDowell teaches how input data is obtained through an interface for location based services." Absent from both the Examiner's analysis and paragraph [0083] is the following concepts: (i) a uniform input interface through which location-based services can be requested using a uniform format and ii) the uniform format being independent of any specific formatting required by a particular service adapter. The Examiner asserting that McDowell teaches that input data is obtained through an interface does not establish that these limitations are identically disclosed.

Independent claim 3 further recites, in part, the following limitation:

> a uniform output interface through which specifically formatted result sets can be formatted using said uniform format, wherein
>
> said uniform input interface adapted to be connected to different service adapters specifying different formats for receiving inputs.

On pages 3 and 4 of the Office Action, as to these limitations, the Examiner cited paragraphs [0080] and [0083] and stated "McDowell teaches how uniform formats can be used to output data in a format different than the input data." Although paragraph [0080] discusses "a final format location 'atom'" (i.e., allegedly corresponding to the claimed uniform format), the Examiner has not established that the format described in paragraph [0080] is also the format that is used to receive the request, as claimed (i.e., claim 3 recites that both the request and the result set are formatted using the uniform format). As to the claimed "uniform input interface adapted to be connected to different service adapters specifying different formats for receiving inputs," the Examiner has neither identified the different service adapters nor identified the "different formats for receiving inputs."

Therefore, for the reasons stated above, Appellants respectfully submit that the Examiner has failed to establish a prima facie case of anticipation in rejecting claim 3 under 35 U.S.C. § 102 based upon McDowell.

Conclusion

Based upon the foregoing, Appellants respectfully submit that the Examiner's rejection under 35 U.S.C. § 102 based upon the applied prior art is not viable. Appellants, therefore, respectfully solicit the Honorable Board to reverse the Examiner's rejection under 35 U.S.C. § 102.

To the extent necessary, a petition for an extension of time under 37 C.F.R. § 1.136 is hereby made. Please charge any shortage in fees due under 37 C.F.R. §§ 1.17, 41.20, and in connection with the filing of this paper, including extension of time fees, to Deposit Account 09-0461, and please credit any excess fees to such deposit account.

Date: August 30, 2007

Respectfully submitted,

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VIII. CLAIMS APPENDIX

1. A method of processing requests from location-based service applications for location-based services provided by a plurality of disparate location-based service providers, different ones of said plurality of disparate location-based service providers specifying different formats for receiving said requests, comprising the steps of the location service:

receiving requests for location based-services;

determining from each said request a particular location-based service provider which can service said request;

specifically formatting each said request according to a specific format specified by said particular location-based service provider;

uniformly formatting each result set produced from corresponding ones of said requests; and,

forwarding said uniformly formatted result sets to the location-based service applications.

2. The method of claim 1, wherein said uniformly formatted result sets are result sets which have been formatted according to the Geography Markup Language (GML).

3. A common location-based service adapter interface, comprising:

a uniform input interface through which location-based services can be requested using a uniform format which is independent of any specific formatting required by a particular service adapter configured to process said location-based services; and,

and a uniform output interface through which specifically formatted result sets can be formatted using said uniform format, wherein

said uniform input interface adapted to be connected to different service adapters specifying different formats for receiving inputs.

4. The common location-based service adapter interface of claim 3, wherein said uniform input interface comprises:

a plurality of location-based service adapter objects, each said adapter object being configured to provide said at least one location-based service responsive to receiving a uniformly formatted location-based service request;

a location service object configured to provide a reference to a particular one of said location-based service adapter objects based upon a specified location-based service; and,

a plurality of location request objects configured to define location-based service request parameters required by generic ones of said location-based service adapter objects.

5. A machine readable storage having stored thereon a computer program for processing requests from location-based service applications for location-based services provided by a plurality of disparate location-based service providers, different ones of said plurality of disparate location-based service providers specifying different formats for receiving said requests, the computer program comprising a routine set of instructions for causing the machine to perform the steps of:

receiving requests for location based-services;

determining from each said request a particular location-based service provider which can service said request;

specifically formatting each said request according to a specific format specified by said particular location-based service provider, and uniformly formatting each result set produced from corresponding ones of said requests; and,

forwarding said uniformly formatted result sets to the location-based service applications.

6. The machine readable storage of claim 5, wherein said uniformly formatted result sets are result sets which have been formatted according to the Geography Markup Language (GML).

IX. EVIDENCE APPENDIX

No evidence submitted pursuant to 37 C.F.R. §§ 1.130, 1.131, or 1.132 of this title or of any other evidence entered by the Examiner has been relied upon by Appellants in this Appeal, and thus no evidence is attached hereto.

X. RELATED PROCEEDINGS APPENDIX

Since Appellants are unaware of any related appeals and interferences, no decision rendered by a court or the Board is attached hereto.